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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/199,604	11/25/1998	DAVID A. SOBESKI	777.172US1	3888

26389 7590 10/21/2002

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EXAMINER

COURTENAY III, ST JOHN

ART UNIT PAPER NUMBER

2126

DATE MAILED: 10/21/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/199,604

Applicant(s)
Sobeski et al.

Examiner
St. John Courtenay III

Art Unit
2126



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Oct 1, 2002
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

ST. JOHN COURTENAY III
PRIMARY EXAMINER

Response to Amendment

- Applicant argues that the cited references do not teach the features of the claimed invention.

Examiner's response:

Applicant's arguments center around the contention that the cited Pugh reference "does not disclose that individual objects possess the ability to modify their own behavior in a dynamic manner, without recoding and recompilation."

However, Applicant admits that Pugh discloses a composite object, also referred to as a cluster, which permits the addition of other objects called role objects. Applicant further acknowledges: "By adding or removing role objects to the cluster, the simulated entity can exhibit dynamic behavioral changes" [see page 4 of the response (paper 8)].

In response, in an alternate interpretation, a composite object can be reasonably construed as a discrete object (in the singular sense) that "exhibits dynamic behavioral changes," as Applicant has acknowledged.

Applicant broadly claims "an object having a plurality of behaviors." The scope of the claim clearly reads upon ANY object that exhibits a plurality of behaviors. A composite object is an object that exhibits a plurality of behaviors, as claimed.

Applicant's arguments impute limitations found in the specification that are not explicitly claimed. Claimed subject matter, not the specification is the measure of the invention. Limitations in the specification cannot be read into the claims for the purpose of avoiding the prior art. See In re Self, 213 USPQ 1, 5 (CCPA 1982); In re Priest, 199 USPQ 11, 15 (CCPA 1978).

The Examiner has broadly interpreted the claims in light of the specification. Examiner

has a duty and responsibility to the public and to Applicant to interpret the claims as broadly as reasonably possible during prosecution. In re Prater, 56 CCPA 1381, 415 F.2d 1393, 162 USPQ 541 (1969).

Applicant's arguments, filed Oct. 1, 2002 (paper #8), have been fully considered but they are not deemed to be persuasive. For the reasons detailed above, all rejections set forth in the previous office action are maintained (including the double patenting rejection).

Claim Rejections - 35 U.S.C. 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1— 19 are rejected under 35 U.S.C. § 102(e) as being anticipated by Pugh et al. (U.S. Patent 6,088,739).

As per independent claim 1:

Pugh teaches a system comprising:

- an object having a plurality of dynamic behaviors [e.g., see "composite object" and the addition and deletion of associated role objects, as discussed beginning col. 5, lines 50-67, continued, col. 6,] ;

- a data store to store data regarding the plurality of dynamic behaviors [e.g., see "composite object" and its capability to include (i.e., store) associated "role objects," see discussion beginning col. 6, line 3; see list and database discussion col. 14, beginning line 54]; and,
- an application to instantiate the object from the data stored in the data store regarding the plurality of dynamic behaviors, wherein the object instantiates at least one of the plurality of dynamic behaviors [e.g., see "create an instance" discussion beginning col. 7, line 3] .

As per claim 2:

Pugh teaches the data store is within the object [e.g., see "role object" discussion beginning col. 6, line 2].

As per claim 3:

Pugh teaches less than all of the plurality of dynamic behaviors of the object are instantiated [e.g., see "producer object" discussion beginning col. 13, line 63, and continued in col. 14] .

As per claim 4:

Pugh teaches the object determines at run-time which of the plurality of dynamic behaviors to instantiate [e.g., see "producer object" discussion beginning col. 14, line 6].

As per claim 5:

Pugh teaches the object comprises a Component Object Model (COM) object [e.g., see discussion beginning col. 14, line 8] .

As per claim 6:

Pugh teaches the plurality of dynamic behaviors comprises at least one selected from the group essentially consisting of: a plurality of objects, a plurality of methods, and a plurality of events [see "register-role", and associated discussion beginning col. 10, line 10].

As per claim 7:

Pugh teaches the data store comprises a registry [e.g., see "register_role" discussion beginning col. 11, line 66, col. 12, lines 59-67, cont'd col. 13; see also "registered properties" col. 14, line 34 and associated discussion; see also "register-role", and associated discussion beginning col. 10, line 10] .

As per claim 8:

Pugh teaches the plurality of dynamic behaviors comprises a plurality of system-defined behaviors and a plurality of application-defined behaviors [e.g., see "role object" discussion beginning col. 6, line 2, and "composite objects," as cited above in the previous rejections].

As per independent claim 9:

This claim is rejected for the same reasons detailed above in the rejection of independent claim 1, and also for the following additional reasons:

Pugh teaches a method comprising:

- receiving a command to instantiate an object having a plurality of dynamic behaviors [e.g., see "create an instance" discussion beginning col. 7, line 3 – a function call is equivalent to a command] .
- looking up data regarding the plurality of dynamic behaviors in a data store [see role list object" discussion , col. 8, beginning line 30]; and,
- instantiating the object from the data regarding the plurality of dynamic behaviors in the data store [e.g., see "create an instance" discussion beginning col. 7, line 3] .

As per claims 10-13:

Pugh teaches changing the plurality of dynamic behaviors [e.g., see "dynamically adds an interface to an object's list of supported interfaces" and associated discussion beginning col. 10, line 11].

As per claim 14:

Pugh teaches looking up data regarding the plurality of dynamic behaviors in the data store as have been changed [see role list object" discussion , col. 8, beginning line 30]; and, instantiating the object from the data regarding the plurality of dynamic behaviors as have been changed stored in the data store [e.g., see "create an instance" discussion beginning col. 7, line 3].

As per claim 15:

Pugh teaches instantiating a second object to provide data regarding the plurality of dynamic behaviors [see role list object" discussion , col. 8, beginning line 30]; and, instantiating the object from the data regarding the plurality of dynamic behaviors [e.g., see "create an instance" discussion beginning col. 7, line 3]

As per independent claim 16:

Pugh teaches a computer-readable medium having data stored thereon representing:

- an object having a plurality of dynamic behaviors [e.g., see "composite object" and the addition and deletion of associated role objects, as discussed beginning col. 5, lines 50-67, continued, col. 6,] ;
- a data store to store data regarding the plurality of dynamic behaviors [e.g., see "composite object" and its capability to include (i.e., store) associated "role objects," see discussion beginning col. 6, line 3; see list and database discussion col. 14, beginning line 54]; and,
- an application to instantiate the object from the data stored in the data store regarding the plurality of dynamic behaviors [e.g., see "create an instance" discussion beginning col. 7, line 3].

As per independent claim 17:

This claim is rejected for the same reasons detailed above in the rejection of the preceding independent claims, and also for the following additional reasons:

Pugh teaches a computer-readable medium having a computer program stored thereon for execution on a computer, the program performing the method comprising:

- receiving a command to instantiate an object having a plurality of dynamic behaviors; looking up data regarding the plurality of dynamic behaviors in a data store [e.g., see "create an instance" discussion beginning col. 7, line 3 – a function call is equivalent to a command] ;
- instantiating the object from the data regarding the plurality of dynamic behaviors in the data store [e.g., see "create an instance" discussion beginning col. 7, line 3];
- changing the plurality of dynamic behaviors [e.g., see "register-role" discussion beginning col. 10, line 10] ;
- looking up data regarding the plurality of dynamic behaviors in the data store as have been changed [see "role list object" discussion , col. 8, beginning line 30]; and,
- instantiating the object from the data regarding the plurality of dynamic behaviors as have been changed stored in the data store [e.g., see "create an instance" discussion beginning col. 7, line 3].

As per independent claim 18:

This claim is rejected for the same reasons detailed above in the rejection of the preceding independent claims, and also for the following additional reasons:

Pugh teaches a computer comprising:

- a memory; a processor [inherent];
- a data store of the memory to store data regarding a plurality of dynamic behaviors of an object [e.g., see "composite object" and its capability to include (i.e., store) associated "role objects," see discussion beginning col. 6, line 3; see list and database discussion col. 14, beginning line 54]; and,

an application executed by the processor from the memory to instantiate the object from the data stored in the data store regarding the plurality of dynamic behaviors [e.g., see "create an instance" discussion beginning col. 7, line 3].

As per claim 19:

Pugh teaches the object comprises a Component Object Model (COM) object, and the data store comprises a registry [see the rejections of claims 5 & 7 above].

Obviousness-type double patenting Rejection:

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

"Double patenting rejection of application claims was fully justified where applicant, in course of expanding first application to disclose enough more by way of details, alternatives, and additional uses to support broad, dominating, generic claims in later applications, has disclosed no additional invention or discovery other than that what was already claimed in patent on first application; there is significant difference between justifying broadening of claims and disclosing additional inventions." *In re Van Ornum*, 214 USPQ 761 (CCPA 1982).

Claims 1-19 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-19 of co-pending application 09/200,674, now U.S. Patent 6,304,879 (Sobeski et al.).

Although the conflicting claims are not identical, they are not patentably distinct from each other because of corresponding language that recites many of the same elements and functions claimed in the previously patented invention, e.g., “dynamic property” (i.e., “dynamic behaviors”), “data store” (i.e., “temporary store”), “received command” (i.e., “receiving a command”), “change data command” (i.e., “changing the plurality of dynamic behaviors”), etc.

The claimed differences would be obvious to a programmer of ordinary skill because the instant claims are merely broader and/or alternate variations of the claims recited in the co-pending case.

For example, independent claim 1 of the instant case more broadly and/or alternately claims:

“A system comprising: an object having a plurality of dynamic behaviors; a data store to store data regarding the plurality of dynamic behaviors; and, an application to instantiate the object from the data stored in the data store regarding the plurality of dynamic behaviors, wherein the object instantiates at least one of the plurality of dynamic behaviors.”

In contrast, claim 1 of the co-pending case (U.S. Patent 6,304,879) more narrowly and/or alternately claims:

“ A system comprising:

a container object comprising

a data object having at least one static property,

a data cache object through which all access to the at least one static property of the data object is made and to temporarily store at least one dynamic property for the data object,

a controller object through which all access to the data cache object is made via at least one of messages and events,

at least one internal object to access the at least one static property and the at least one dynamic property; and

at least one external object to access the at least one static property and the at least one dynamic property, wherein the external object is external to the container object, and wherein the container object, the data object, the data cache object, the controller object, the at least one internal object, and the at least one external object all comprise respective encapsulated data and a respective method for accessing the respective encapsulated data in an object-oriented computing environment.

Because the instant claims merely eliminate and/or alternately claim limitations from the set of elements and functions claimed in the co-pending case, such modifications would be readily apparent to a programmer of ordinary skill.

Terminal Disclaimer

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b). Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

For post GATT applications, (i.e., applications filed after June 8, 1995), the rule § 1.321 (4) (c) (3) requires a provision that must be included. The following requirement is UNCHANGED by GATT and therefore a terminal disclaimer is required for the instant application, i.e., "shall be enforceable only for and during such period that said patent is commonly owned with the application or patent which formed the basis for the rejection."

§ 1.321 Statutory disclaimers, including terminal disclaimers.

(a) A patentee owning the whole or any sectional interest in a patent may disclaim any complete claim or claims in a patent. In like manner any patentee may disclaim or dedicate to the public the entire term, or any terminal part of the term, of the patent granted. Such disclaimer is binding upon the grantee and its successors or assigns. A notice of the disclaimer is published in the Official Gazette and attached to the printed copies of the specification. The disclaimer, to be recorded in the Patent and Trademark Office, must:

- (1) Be signed by the patentee, or an attorney or agent of record;
- (2) Identify the patent and complete claim or claims, or term being disclaimed. A disclaimer which is not a disclaimer of a complete claim or claims, or term will be refused recordation;
- (3) State the present extent of patentee's ownership interest in the patent; and
- (4) Be accompanied by the fee set forth in § 1.20(d).

(b) An applicant or assignee may disclaim or dedicate to the public the entire term, or any terminal part of the term, of a patent to be granted. Such terminal disclaimer is binding upon the grantee and its successors or assigns. The terminal disclaimer, to be recorded in the Patent and Trademark Office, must:

- (1) Be signed:
 - (i) By the applicant, or
 - (ii) If there is an assignee of record of an undivided part interest, by the applicant and such assignee, or
 - (iii) If there is an assignee of record of the entire interest, by such assignee, or
 - (iv) By an attorney or agent of record;
- (2) Specify the portion of the term of the patent being disclaimed;
- (3) State the present extent of applicant's or assignee's ownership interest in the patent to be granted; and
- (4) Be accompanied by the fee set forth in § 1.20(d).

(c) A terminal disclaimer, when filed to obviate a judicially created double patenting rejection in a patent application or in a reexamination proceeding, must:

- (1) Comply with the provisions of paragraphs (b)(2) through (b)(4) of this section;
- (2) Be signed in accordance with paragraph (b)(1) of this section if filed in a patent application or in accordance with paragraph (a)(1) of this section if filed in a reexamination proceeding; and
- (3) Include a provision that any patent granted on that application or any patent subject to the

reexamination proceeding **shall be enforceable only for and during such period that said patent is commonly owned with the application or patent which formed the basis for the rejection.**

[47 FR 41281, Sept. 17, 1982, effective Oct. 1, 1982; revised, 58 FR 54504, Oct. 22, 1993, effective Jan. 3, 1994; para. (c) revised, 61 FR 42790, Aug. 19, 1996, effective Sept. 23, 1996]

THIS ACTION IS MADE FINAL.

Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

How to Contact the Examiner:

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to **St. John Courtenay III** whose voice telephone number is (703) 308-5217. A voice mail service is also available at this number.

- All responses sent by U.S. Mail should be mailed to:
**Commissioner of Patents and Trademarks
Washington, D.C. 20231**
- Hand-delivered responses should be brought to **Crystal Park Two, 2021 Crystal Drive, Arlington, VA., Fourth Floor (Receptionist)**. All hand-delivered responses will be handled and entered by the docketing personnel. Please do not hand deliver responses directly to the Examiner.

PTO FAX NUMBERS:

- AFTER-FINAL faxes must be signed and sent to: (703) 746-7238.
- OFFICIAL faxes must be signed and sent to: (703) 746-7239.
- NON OFFICIAL faxes should not be signed, please send to: (703) 746-7240, or to Examiner Courtenay's desktop computer at 703-746-5472.

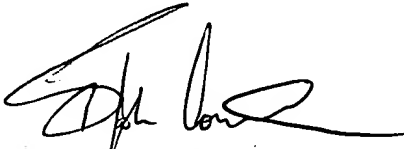
All OFFICIAL faxes will be handled and entered by the docketing personnel. The date of entry will correspond to the actual FAX reception date unless that date is a Saturday, Sunday, or a Federal Holiday within the District of Columbia, in which case the official date of receipt will be the next business day. The application file will be promptly forwarded to the Examiner unless the application file must be sent to another area of the Office, e.g., Finance Division for fee charging, etc.

To avoid ongoing Washington D.C. area mail processing delays, the Examiner requests that Applicant direct all communications to the PTO by fax. All incoming faxes are securely stored on PTO computers that are dedicated to fax reception. If you send a fax, please do not send duplicate papers via U.S. mail.

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- Any inquiry of a general nature or relating to the status of this application should be directed to the **TC 2100 Group receptionist: (703) 305-3900.**

Please direct inquiries regarding fees, paper matching, and other issues not involving the Examiner to: Technical Center 2100 CUSTOMER SERVICE: 703 306-5631

Normal Flex work schedule: Monday – Friday 7:30 AM – 4:00 PM


**ST. JOHN COURTENAY III
PRIMARY EXAMINER**

Paper #9